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BAYARD, DJENANE M	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

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Technology Center 2100

Application Number: 10/027,163
Filing Date: December 20, 2001
Appellant(s): COUTS ET AL.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

Hisashi D. Watanabe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/27/07 appealing from the Office action mailed 9/26/06.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6584494	Manabe et al	6-2003
6993564	Whitten, II	1-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the ~~applicant~~ appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6, 8, 11-13, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6584494 to Manabe et al in view of U.S. Patent No. 6, 993564 to Whitten, II.

a. As per claim 1, Manabe et al teaches a communication support system and method for promoting smooth communication in a chat system. Furthermore, Manabe et al teaches a method for a data network system for responding to a communication message, the method comprising the steps of: receiving a communication message directed to a target device from an originating device (See col. 4, lines 31-32 and col. 6, lines 35-41, the detection means detects the sending of any text information from a first communication device on the network); retrieving configuration data of the target device; determining whether the target device is available for

interactive communication with the originating device based on the configuration data (See col. 4, lines 32-39 and col. 6, lines 46-50, the acquisition means detects whether a second communication device correlated with the detected text information is operating and acquires from the second communication device the user status); routing the communication message to the target device if the target device is available for interactive communication with the originating device (See col. 8, lines 62-65 and figure 7); and sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 7, lines 42-65). Furthermore, Manabe et al teaches wherein the communication message includes an originating identification associated with the originating device and a target identification associated with the target device (See col. 3, lines 10-15 and col. 4, lines 30-40). However, Manabe et al fails to teach retrieving configuration data of the target device based on the target identification, the configuration data including a plurality of classes and a plurality of canned replies associated with the plurality of classes and identifying an originating class of the originating device from the plurality of classes and a canned reply associated with originating class based on the originating identification.

Whitten, II teaches a method of authorizing receipt of instant messages by a recipient user. Furthermore, Whitten, II teaches wherein the a potential recipient of an instant message prepares a list of senders whose instant messages are controlled by the potential recipient and if properly authorized will be acceptable to receipt by the recipient. The recipient breaks the list into several categories expressing the possible interests of senders as indicated by the block 203. Acceptable senders are listed in each category. Individual senders may be listed in more than one category, as indicated in block 207. Included with each category is a list of status indicators

as shown in the block 205. These place restrictions in receiving instant messages from otherwise acceptable senders. For example an otherwise authorized sender may be able to send an instant message to a recipient only in an emergency or for an otherwise specified purpose. In another state, the recipient may grant absolute approval to all potential senders in a selected category. In the beginning of each active session a potential recipient, as indicated in the block 209, selects from categories and the status in each category to indicate acceptable instant messages from particular senders and for specified reasons (See col. 3, lines 22-44 and figure 2).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Whitten, II into the claimed invention of Manabe et al in order to allow potential recipient to specify availability to receive instant messages from a plurality of list to select or activate desired list of senders (See col. 2, lines 30-40).

b. As per claim 2, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the interactive communication is conducted in real-time between an originating user of the originating device and the target user of the target device (See col. 6, lines 63-67)

c. As per claim 3, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the step of determining includes the step of detecting whether an instant messaging application of the target device is active (See col. 7, lines 8-20).

d. As per claim 4, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches configuring the canned reply by the target device before the step of receiving the communication message from the originating device (See col. 7, lines 43-45).

e. As per claim 11, Manabe et al teaches a data network system for responding to a communication message, the data network system comprising: a messaging server for communicating with a plurality of client devices, the messaging server being effective to route the communication message from an originating device to the target device (See col. 6, lines 23-26 and figure 1); to send the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 3, lines 45-60). However, Manabe et al fails to teach to receive a communication message directed to a target device from an originating device, retrieve a plurality of classes and a plurality of canned replies associated with the target device, identify an originating class of the originating device from the plurality of classes and a canned reply associated with the originating class based on the originating device.

Whitten, II teaches a method of authorizing receipt of instant messages by a recipient user. Furthermore, Whitten, II teaches wherein the a potential recipient of an instant message prepares a list of senders whose instant messages are controlled by the potential recipient and if properly authorized will be acceptable to receipt by the recipient. The recipient breaks the list into several categories expressing the possible interests of senders as indicated by the block 203.

Acceptable senders are listed in each category. Individual senders may be listed in more than one category, as indicated in block 207. Included with each category is a list of status indicators as shown in the block 205. These place restrictions in receiving instant messages from otherwise acceptable senders. For example an otherwise authorized sender may be able to send an instant message to a recipient only in an emergency or for an otherwise specified purpose. In another state, the recipient may grant absolute approval to all potential senders in a selected category. In the beginning of each active session a potential recipient, as indicated in the block 209, selects from categories and the status in each category to indicate acceptable instant messages from particular senders and for specified reasons (See col. 3, lines 22-44 and figure 2, See col. 3, lines 45-60 and figure 3).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Whitten, II into the claimed invention of Manabe et al in order to allow potential recipient to specify availability to receive instant messages from a plurality of list to select or activate desired list of senders (See col. 2, lines 30-40).

f. As per claims 6 and 16, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for configuration of the originating device exist (See col. 7, lines 1-7).

g. As per claims 8 and 18, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for

configuration of the target device exist (See col. 9, lines 55-64).

h. As per claim 12, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the messaging proxy is incorporated within the messaging server (See col. 4, lines 24-29).

i. As per claim 13, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the target device includes an instant messaging application that is active (See col. 7, lines 25-40).

5. Claims 5, 7, 9, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,584,494 to Manabe et al in view of Whitten, II as applied to claim 1 and 11 above, and further in view of U.S. Patent No. 6,430, 604 to Ogle et al.

a. As per claims 5 and 15, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device.

Ogle et al teaches a technique for enabling messaging systems to use alternative message delivery mechanism. Furthermore, Ogle et al teaches wherein if the test has a negative result then the message can not be sent (See col. 11, lines 4-14).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device as taught by Ogle et al in the claimed invention of Manabe et al in view of Whitten, II in order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

b. As per claims 7 and 17, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices.

Ogle et al teaches the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices (See col. 8, lines 30-55).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices as taught by Ogle et al in the claimed invention of Manabe et al in view of Whitten, II in

order to order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

c. As per claims 9 and 19, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area.

Ogle et al teaches the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area (See col. 3, lines 36-49).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area as taught by Ogle in the claimed invention of Manabe et al in view of Whitten, II in order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

6. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Paten U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,993564 to Whitten,

II as applied to claim 1 and 11 above, and further in view U.S. Patent 6,301603 To Aravamudan et al.

a. As per claims 10 and 20, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication.

Aravamudan et al teaches an assignable associate priorities for user-definable instant messaging buddy groups. Furthermore, Aravamudan et al teaches the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication (See col. 7, lines 20-65).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication as taught by Aravamudan et al in the claimed invention of Manabe et al in view of Whitten, II in order to provide features and capabilities associated with existing and emerging

Instant messaging services and communication protocols to locate a registered user, query the user for a proposed message disposition or other action (See col. 2, lines 25-30).

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Paten U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,993564 to Whitten, II as applied to claim 1 and 11 above, and further in view of U.S. Patent Application No 2004/0048615 to Kato et al

a. As per claim 14, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device.

Kato et al teaches a mobile packet communication system. Furthermore, Kato et al teaches a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device (See page 5, paragraph [0095]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device as taught by Kato et al in the claimed invention of Manabe et al in view Whitten, II in order to store for each mobile terminal address the current location of the corresponding mobile terminal (See page 5, paragraph [0095]).

(10) Response to Argument

~~Applicant~~Appellant argues that Whitten does not disclose any type of canned reply associated with an originating class.

Referring to the specification, a specific definition was not provided for "canned reply", therefore, the Examiner is entitled to use the broadest reasonable interpretation. Those of ~~known to one with~~ ordinary skill in the art would reasonably construe the terminology "canned reply" as referring to~~. Usually a canned reply is~~ a predefined or preset message arranged by the potential recipient of a message.

The Examiner disagrees with appellant's contention that Whitten fails to teach a "canned reply". ~~However,~~ Whitten ~~et al~~ teaches ~~wherein~~ that acceptable senders are listed in each category (*dividing the senders into a plurality of classes*) (See col. 3, lines 32-35). Furthermore, Whitten teaches ~~wherein~~ the use of status indicators which are ~~(~~preset messages (i.e. canned replies) that are sent in response to a communication from an acceptable sender~~ defined by the potential recipient are communicated to the potential sender~~ (See Figure 3, 303-305). Therefore, Whitten clearly teaches ~~wherein~~ a canned reply (status indicator) associated with an originating class (*senders listed in category*).

As stated by ~~Applicant~~ Appellant 's representative in the Appeal Brief on page 4, paragraph [4], "Whitten describes a sender sending query to a potential recipient and in response, the potential recipient sending availability and receptivity information back to the sender. However, the Examiner disagrees that the av~~i~~ailability and receptivity information sent by the potential recipient is not a canned reply associated with the originating class. The availability

and receptivity information sent by the potential recipient is a predefined message communicated from the recipient to the potential sender and therefor meets the definition of a canned reply. Accordingly, the rejection(s) made by the examiner should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Djenane Bayard

Patent Examiner

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